

Remarks

Claims 1 through 6 and 9 through 18 are now pending

Claim 1 has been amended in response to the Examiner's observations under 35 U.S.C.

Section 112, second paragraph.

The Rejection

The following patent publications have been relied upon to reject the Applicants claims:

<u>U.S. Patents</u>	
6,046,266	Sandstrom et al (Sandstrom)
5,929,157	Matsou – newly cited
5,284,898	Thise – newly applied
4,703,079	Ahmad – newly cited

<u>Other</u>	
WO 99/52720	Brown, et al (Brown)

First Rejection

The Applicants' claims 1 through 6 and 9 through 18 have been rejected under 35 U.S.C. Section 103(a) over Brown in view of Sandstrom and Thise and optionally in view of Ahmad. The rejection is traversed with a request for reconsideration.

Second Rejection

The Applicants' claims 1 through 6 and 9 through 18 have been rejected under 35 U.S.C. Section 103(a) over Brown in view of Matsou and Thise and optionally in view of Ahmad. The rejection is traversed with a request for reconsideration.

Non-Statutory Double Patenting Rejection

Claims 1 through 18 had been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over various claims of co-pending application Serial No. 09/260,815 in view of Sandstrom or Thise (U.S. Patent No. 5,284,989).

Co-pending application Serial No. 09/260,815 may be expressly abandoned, pending otherwise allowable claims being found for this instant patent application. When and if such

express abandonment of the co-pending application is made, and confirmation received, this instant application is to be amended to reflect that application Serial No. 09/260,815 is abandoned.

The Invention

It is important to appreciate that the invention of the Applicants' claims is based on a cooperative combination of tire tread and sidewall structure (lug and groove configuration) and significantly differentiated rubber compositions, namely that the lug and groove configured tread is of one rubber composition and the lug and groove configured portion of the sidewall is of another significantly different rubber composition.

Accordingly, the rubber composition of the lug and groove configured portion of the tread intended to be ground-contacting is in a sense de-coupled from the rubber composition of the lug and groove configured portion of the sidewall.

In particular, the rubber composition of the lug and groove configured portion of the tread intended to be ground-contacting is required to be reinforced with carbon black of a required Iodine and DBP value characterization and is exclusive of a combination of silica reinforcement and coupling agent.

In particular, the rubber composition of the lug and groove configured portion of the sidewall (which is structurally an extension of the lug and groove configuration of the tread) is required to be reinforced with precipitated silica in combination with a coupling agent for the silica with only a minor amount of carbon black reinforcement for which the carbon black itself has Iodine and DBP values distinguished from and different than such values required for the carbon black reinforcement for the tread.

Indeed, it is contended that such combination of tread lug and groove configuration with the de-coupled (significantly differentiated) rubber composition of the sidewall lug and groove configuration is a significant departure from both past practice and the cited references.

First Rejection (Brown in view of Sandstrom and Thise and optionally in view of Ahmad

A. 35 U.S.C. 103(c) Consideration for Brown in view of Sandstrom

Claims 1 through 6 and 9 through 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Brown in view of Sandstrom (U.S. Patent No. 6,046,266) and Thise and optionally Ahmad. Under 35 U.S.C. Section 103(c), it appears that it would be inappropriate to use the Sandstrom reference to support a rejection of the Applicant's claims under 35 U.S.C. Section 103(a). More specifically, 35 U.S.C. 103(c) reads as follows:

"Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) or section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time of the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

35 U.S.C. Section 103(c) applies to U.S. patents filed on or after November 29, 1999. The Applicants' instant Continuation-In-Part patent application was filed on February 9, 2001. Thus 35 U.S.C. Section 103(c) apparently applies to this Continuation-In-Part patent application. The invention of Sandstrom and the invention claimed by the Applicants' instant patent application were commonly owned, or under an obligation of assignment to the same person. This is evidenced by the fact that both the Sandstrom patent and the Applicants' patent application have been assigned to The Goodyear Tire & Rubber Company. Sandstrom identifies The Goodyear Tire & Rubber Company as the assignee on its face. A copy of the assignment of the Applicants' instant patent application to The Goodyear Tire & Rubber Company is submitted herewith. Thus the Sandstrom reference apparently does not qualify as prior art under 35 U.S.C. Section 102(e), (f) or (g). It appears that none of the other subsections of 35 U.S.C. Section 102 can be used to support a rejection of the Applicants' claims under 35 U.S.C. Section 103.

Furthermore, Sandstrom should not be prior art that can be used to support a rejection of the claims of the Applicants' patent application under 35 U.S.C. Section(s) 102(a)/103. The

patent application on which the Sandstrom patent was based was pending in the United States Patent and Trademark Office from September 24, 1998 to April 4, 2000. During the pendency of an application in the United States Patent and Trademark Office, information contained in that application is considered confidential. In particular, under 35 U.S.C. Section 122, patent applications in the United States Patent and Trademark Office are secret documents, namely that ". . . applications for patents shall be kept in confidence by the Patent and Trademark Office. . .".

Accordingly, it appears that Sandstrom should not be deemed to be prior art under 35 U.S.C. Section (s) 102(a)/103 and thereby would be inappropriate to support a rejection of the Applicants' claims predicated on obviousness by 35 U.S.C. Section(s) 102(a)/103 because the publication of the Sandstrom reference by the United States Patent Office (April 4, 2000) was not available to the general public more than one year prior to the filing date of the Applicants' Continuation-In-Part patent application, namely February 9, 2001, and, moreover, any publication of any corresponding Sandstrom patent application by any other country requiring a patent application publication date of 18 months following the U.S. priority date would have been published on or about June 24, 2000, therefore also not available to the public more than one year prior to the U.S. filing date of the Applicants' Continuation-In-Part patent application.

It is acknowledged that the Examiner's cited Brown patent recites the existence of the Sandstrom patent application by its Serial No. 09/159,663 filed September 24, 1998 without specifically incorporating the Sandstrom reference into the Brown specification. Indeed, such recitation in the Brown reference is not seen to publish the Sandstrom patent application itself so that the Sandstrom patent application specification remained on a secret status within the United States Patent and Trademark Office prior to its granting date of April 4, 2000.

The Brown patent publication indicates a publication date of October 21, 1999, which is more than one year prior to the U.S. filing date of February 9, 2001. Therefore, while the

Brown is available as representing prior art, it is not seen that it validates the Sandstrom patent reference itself as being appropriate prior art against the Applicants' Continuation-In-Part patent application.

It is, accordingly, contended that the Sandstrom patent reference is not prior art that can be used to support a rejection of the Applicants' claims under 35 U.S.C. Section(s) 102(a)/103 because the Sandstrom patent or patent application was not published more than one year prior the filing date the Applicants' Continuation-In-Part patent application and that the Brown reference is not effective to publish the Sandstrom specification.

It is therefore contended that the rejection of the Applicants' claims under 35 U.S.C. Section 103(a) based upon the combination of Brown in view of Sandstrom and Thise and optionally in view of Ahmad is not tenable since it appears that the Sandstrom reference of the combination of references cannot be used as a reference against the Applicants' claims.

B. Further Discussion (35 U.S.C. Section 103(a)): Brown in view of Sandstrom and Thise and optionally in view of Ahmad

Brown is directed to a tire tread, of lug and groove configuration, which is constructed of three zones, namely a central zone and two lateral zones, all intended to be ground contacting. A portion of the lateral zone of the tread (41, 42 and 49) is an extended part of the tread (40) over the tire shoulder down the tire's sidewall. However, the tire sidewall of Brown is depicted as being a part of the tire casing (12) as shown in Figure 4.

The portion of the tire tread (41, 42, and 49) is apparently a structural extension of the tread (40) over the tire casing (the tire sidewall) and is therefore differentiated from and appears to be compositionally de-coupled from the sidewall rubber composition of the tire casing itself. Accordingly, it is contended that the recitation in Brown of the tire sidewall being of natural rubber and cis 1,4-polybutadiene which contains as reinforcement a combination of carbon black and precipitated silica together with a coupling agent refers to the

sidewall of the tire casing and not the extended portion of the tire tread (41, 42 and 49) which is depicted as extending over the tire shoulder down the tire sidewall.

Therefore, the Applicants' required compositional de-coupling of the lug and groove configured tire tread intended to be ground-contacting from the lug and groove configured tire sidewall is not seen as being taught or suggested by the Brown disclosure and, moreover, it is contended that the disclosure of Brown actually leads away from the de-coupling of the rubber compositions for the lug and groove portions of the tread and of the sidewall as is required by the Applicants' claims.

The following discussion is presented relating to the cited Sandstrom reference, although it is contended that the Sandstrom specification itself is not available as prior art insofar as the Applicants' instant patent application is concerned.

Clearly Sandstrom does not teach or suggest the Applicants' required significantly two distinct and contrasting rubber compositions for the required lug and groove configured tread and lug and groove configured portion of the tire sidewall. Insofar as the recitation in the Brown reference is concerned, it appears that the Sandstrom citation refers to the tire sidewall (e.g. the tire casing) and not the extension of the lug and groove configured tread as hereinbefore discussed.

Accordingly, Sandstrom is significantly and materially deficient for a purpose of rejecting the Applicants' claimed invention under the requirements of 35 U.S.C. Section 103(a) and, as hereinbefore pointed out, is not seen as being available as prior art for citation against the Applicants' claimed invention.

Therefore, it is contended that a combination of Brown and Sandstrom is not tenable and, moreover, does not make out a *prima facie* case of obviousness of the Applicants' claimed invention.

Thise and Ahmad are cited to show that a high structure carbon black can be used for a tire tread rubber composition of solution SBR, natural rubber and cis 1,4-polyisoprene for a truck tire. However neither Thise nor Ahmad teach or suggest the Applicants' required compositionally decoupled lug and groove tread rubber composition and the lug and groove configured sidewall composition.

Indeed, as hereinbefore emphasized, that it is an essence of the Applicants' claimed invention of the use of significantly different rubber compositions for the lug and groove configured tire tread and for the lug and groove configured tire sidewall and that such compositional de-coupled rubber construction combination is a significant departure from past practice. Nowhere in any of the secondary Thise and Ahmad references is there taught or suggested the lug and groove configurations of the tread combined with the sidewall in which the tread rubber composition and rubber composition of the lug and grooved configured sidewall tread extension significantly differ from each other, particularly where the sidewall portion contains both precipitated silica and specified carbon black and the tread portion excludes precipitated silica reinforcement and requires carbon black reinforcement which is significantly different from the carbon black of the sidewall portion.

Accordingly, it is not seen that the secondary Thise and Ahmad remedy the significant and material deficiencies of the aforesaid Brown and Sandstrom references.

Therefore, it is contended that a combination of the Brown and Sandstrom (which is contended is not available as prior art) with either or both of Thise and Ahmad references does not make out a *prima facie* case of obviousness of the Applicants' claims under the requirements of 35 U.S.C. Section 103(a).

C. Response to Examiner's Presentation

The Examiner has presented comparative compositional data to compare the rubber composition described in the Sandstrom referenced specification with the lug and groove

sidewall composition required by the Applicants' claims. It is contended that such compositional comparison of the rubber compositions is not appropriate first because the Sandstrom specification itself is not available as prior art against the Applicants' instant patent application and, secondly because the Brown reference relates to the composition of the sidewall of the tire casing and rather than to the lug and groove extension (41, 42 and 49) of the tread (40) over the tire's sidewall.

Furthermore, it is respectfully submitted that the Examiner has not considered the claimed invention as a whole as is required by law, and that it is not correct for the Examiner to simply pick and choose among isolated disclosures in the cited references and piece them together by a hindsight reconstruction. (See In re Fritch, 972 F.2d 1260; 23 U.S.P.Q. 2d 1780.)

Second Rejection (Brown in view of Matsou and Thise and optionally in view of Ahmad)

The Applicants' claimed invention is differentiated from the Brown, Thise and Ahmad references as presented in the Applicants' above First Rejection discussion.

The Matsou reference has been cited to show a tire sidewall rubber composition composed of at least 30 parts of natural rubber, 30 to 70 parts of polybutadiene rubber, 5 to 50 parts of carbon black (e.g. N550), 10 parts of silica and coupling agent. Matsou is not directed to any lug and groove configured tire sidewall.

Accordingly, Matsou does not correct the aforesaid significant deficiencies of the Brown reference.

Therefore, it is contended that the combination of Brown, Matsou, Thise and optional Ahmad references does not make out a *prima facie* case of obviousness of the Applicants' claims under the requirements of 35 U.S.C. Section 103(a).

Conclusion

It is contended that the Applicant's claims, particularly claim 1, which requires a tire having both a lug and groove configured tread and lug and groove configured sidewall in

combination with significantly separate rubber compositions for the respective tread and sidewall lug and groove configurations, is novel and are patentably distinct from the combinations of cited references.

Respectfully submitted,


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